

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peng Cho TANG et al.

Title: INDOLINONE COMBINATORIAL LIBRARIES AND RELATED PRODUCTS AND METHODS FOR THE TREATMENT OF DISEASE

Appl. No.: 10/076,621

Filing Date: 02/19/2002

Examiner: Laura Lynne Stockton

Art Unit: 1626

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
Box NON-FEE AMENDMENT  
Washington, D.C. 20231

Sir:

In response to the restriction requirement set forth in the Office Action mailed December 3, 2002, Applicants hereby provisionally elect Group III, Claims 5-11 and 13, wherein the elected species is represented by the formula in claim 6, wherein R1 is methyl, and all the remaining R groups are hydrogen, for examination, with traverse. Applicants contend the restriction is improper with respect to Groups III, IV and V.

Applicants contend that the Examiner has failed to establish a *prima facie* case that the restriction is proper. As stated in MPEP § 803:

“an application may properly be restricted to one of two or more inventions only if they are able to support separate patents and they are either independent or distinct. If the search of the entire application can be made without serious burden, the examiner **must** examine it on the merits, **even though** it includes claims to independent or distinct inventions.” (MPEP § 803, emphasis added.). “There are two criteria for a proper requirement for restriction between two patentably distinct inventions: (A) The inventions must be independent or distinct

as claimed; **and** (B) There must be a serious burden on the examiner if restriction is required." (*Id.*, emphasis added, citations omitted.)

Applicants urge that the Examiner has not offered sufficient evidence to demonstrate part (B), that a serious burden exists. In particular, applicants note that Groups III and IV are in the same search class, Class 548, subclass 454+, and, therefore, would not constitute any burdensome search because both claims could be searched at the same time. Moreover, as a result of the *Ochiai* decision, applicants are entitled to have method claims rejoined if the composition claims are found to be patentable. If the Examiner will not presently examine at least claim 12 (Group IV), applicants will seek rejoinder upon the finding of allowable subject matter. With respect to the restriction between Groups III and V, applicants contend that no undue burden exists, as a search of the compounds will relate to the methods of use for these compounds.

This election of claims is made with traverse and without prejudice to applicants' right to pursue the non-elected claims in one or more divisional applications in due course.

Respectfully submitted,

Date January 2, 2003

By 

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.